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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/593,820	09/22/2006	Kouji Kitahata	AI-431NP	4741

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RABIN & Berdo, PC
1101 14TH STREET, NW
SUITE 500
WASHINGTON, DC 20005

EXAMINER	
OLADAPO, TAIWO	

ART UNIT	PAPER NUMBER
1797	

MAIL DATE	DELIVERY MODE
09/01/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/593,820	KITAHATA ET AL.	
	Examiner	Art Unit	
	TAIWO OLADAPO	1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 August 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4,5 and 7-9* is/are pending in the application.

4a) Of the above claim(s) *8 and 9* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4,5 and 7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 September 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. The amendment dated 08/11/2010 have been considered and entered for the record. The amendment cancels previous claim 6 and adds previous limitations from now cancelled claim 6 to claim 1. The amendment does not overcome the rejections which are hereby maintained.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/11/2010 has been entered.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1, 2, 4, 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakatani et al. (US 2003/0176298) in view of Aoki et al. (US 5,354,487).

7. In regards to claims 1, 2, 4, 5, Nakatani teaches a lubricant composition for rolling bearings [title, 0075], comprising a thickener of a calcium sulfonate and calcium carbonate complex and base oil according to the limitations of claim 2 [abstract, 0050]. Nakatani does not recite that the lubricant comprises fine particles.

Aoki teaches solid lubricant additives for use in bearings, and in gear oils, bearing oils and greases as in the invention of Nakatani (column 1 lines 46 – 52). The solid lubricants are cured products having particle sizes of less than 100mm, and are thus fine particles meeting the limitations of claims 1, 4, 5. The fine particles are made of thermoplastic resins such as polyethylene, polyester, polyimide and polyurethane resins which are examples of materials for making the buffer particles in the applicant's specification, paragraph 0025, thus meeting the claimed limitations.

Aoki teaches the particles are cured polybutadiene are present in lubricating compositions in the amount of from 0.01 to 50 parts by weight based on 100 parts by weight of the lubricating oil. Nakatani teaches the thickener composition comprises from 5 to 95% of the calcium sulfonate complex and is present at about 3 to 40% in the lubricant [0053, 0055]. Thus the calcium sulfonate complex is present in the lubricant at about 0.15 to 38%. The percent of particles in the composition of the combined invention will therefore overlap the limitation of claim 6. In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

It would have been obvious for one of ordinary skill in the art at the time of the invention to have used the particles of Aoki in the bearing oil of Nakatani, as Aoki teaches that the particles are suitable for use in bearing oils or greases.

8. In regards to claim 7, Nakatani and Aoki combined teach the lubricant composition wherein the base oil has a kinematic viscosity of between 50 and 500 mm^2/s at 40°C (Nakatani, abstract). Since the composition has the same ingredients meeting the limitations of claim 1, it will also have similar mixing consistency at the recited temperature.

Response to Arguments

9. Applicants' arguments have been fully considered but they are not persuasive.

10. The applicants primarily argue that the references of Nakatani and Aoki combined do not teach the newly added limitations to claim 1, which were previously present in now cancelled claim 6. The limitations require a lubricant composition to have a mixing consistency at 25C

adjusted to range from 265 to 475, and to comprise buffer particles in amounts of from 20 to 300 parts by weight. The arguments are not persuasive. As recited above, Nakatani and Aoki combined teach lubricant compositions comprising polybutadiene particles which serve as buffer particles in the grease and are present in amounts of from 0.01 to 50 parts by weight which overlaps the range in the claim as discussed above. Since similar lubricant and additives are taught, the mixing consistency of the grease will be similar to the claim.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAIWO OLADAPO whose telephone number is (571)270-3723. The examiner can normally be reached on 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571)272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TO

/Ellen M McAvoy/
Primary Examiner, Art Unit 1797